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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,865	11/16/2000	Diego H Castrillon	B0801/7195	4880

7590 06/18/2004

Elizabeth R Plumer
Wolf Greenfield & Sacks PC
600 Atlantic Avenue
Boston, MA 02210

EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,865

Applicant(s)

CASTRILLON, DIEGO H

Examiner

Karen A Canella

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3, 4 and 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachments

DETAILED ACTION

Claim 4 has been amended in the amendment filed May 15, 2004. Claims 1-4 and 22 are pending and under consideration.

After review and reconsideration, the finality of the previous Office action is withdrawn.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22 is drawn to a kit comprising "an agent" that selectively binds to the isolated nucleic acid of claim 1. When given the broadest reasonable interpretation, the claims read on DNA binding enzymes, and other molecules which are not restricted to nucleic acids which hybridize to SEQ ID NO:1. The specification discloses only nucleic acids which hybridize to SEQ ID NO:1 and thus does not adequately describe a genus of "agents".

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:15, does not reasonably provide enablement for fragments of SEQ ID NO:15. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claim 15 embodies the isolated nucleic acids of claim 1 which hybridize under stringent conditions to SEQ ID NO:1 and code for a human vasa polypeptide. The specification teaches that vasa polypeptides are restricted to expression in germ cells and tumors thereof. The specification has not provided teaching of a subfragment of SEQ ID NO:15 which would encode a vasa polypeptide. One of skill in the art would be subject to undue experimentation in order to make a subfragment of SEQ ID NO:15 that would be expressed only in germ cells.

Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Edwards (US 6,636,063) as evidenced by the attached sequence alignment. Edwards discloses SEQ ID

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NOI:2923 which is an isolated DNA fragment of SEQ ID NO:1 of 504 nucleic acids, thus fulfilling the specific embodiment of between 8 and 2223 nucleotides.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571)272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Canella, Ph.D.

06/17/2004


KAREN A. CANELLA PH.D
PRIMARY EXAMINER

GenCore version 5.1.6
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OM nucleic - nucleic search, using sw model

Run on: May 9, 2004, 15:44:13 ; Search time 167.964 Seconds
(without alignments)
7348.085 Million cell updates/sec

Title: US-09-714-865-1

Perfect score: 2234

Sequence: 1 acttgagatccaccatggggg.....aagtgtgtgtttgatgca 2224

Scoring table: IDENTITY NUC

Gapop 10_0 , Gapext 1.0

Searched: 682709 seqs, 277475446 residues

Total number of hits satisfying chosen parameters: 1355418

Minimum DB seq length: 0

Maximum DB seq length: 2000000000

Post-processing: Minimum Match 0%

Maximum Match 100%

Listing first 45 summaries

Database : Issued Patents NA:*

1: /cgn2_6/prodata/2/ina/5A-COMB.seq:*

2: /cgn2_6/prodata/2/ina/5B-COMB.seq:*

3: /cgn2_6/prodata/2/ina/5A-COMB.seq:*

4: /cgn2_6/prodata/2/ina/5B-COMB.seq:*

5: /cgn2_6/prodata/2/ina/5A-COMB.seq:*

6: /cgn2_6/prodata/2/ina/5B-COMB.seq:*

pred. No. is the number of results predicted by chance to have a score greater than or equal to the score of the result being printed, and is derived by analysis of the total score distribution.

SUMMARIES

Result No.	Score	Query Match	Length	DB ID	Description
1	493	22.2	504	US-09-621-976-2923	Sequence 2923, App
2	389.8	17.5	420	US-09-833-381-1475	Sequence 1475, App
3	386.4	17.4	2451	US-09-976-594-786	Sequence 786, App
4	383.2	17.2	2319	US-09-058-489-90	Sequence 90, Appl
5	383.2	17.2	4416	US-09-058-489-17	Sequence 17, Appl
6	369.4	16.6	3408	US-09-058-489-14	Sequence 14, Appl
7	369.4	16.6	5322	US-09-058-489-13	Sequence 13, Appl
8	158.2	7.1	2365	US-09-183-706-42	Sequence 42, Appl
9	158.2	7.1	2365	US-09-567-995-42	Sequence 509, App
10	129.4	5.8	1191	US-09-328-352-509	Sequence 213, App
11	129	5.8	3760	US-09-976-594-213	Sequence 1401, App
12	127.6	5.7	1410	US-09-543-681A-1401	Sequence 1, Appli
13	125.6	5.6	1830121	US-09-557-884-1	Sequence 1, Appli
14	125.6	5.6	1830121	US-09-643-990A-1	Sequence 1, Appli
15	123.6	5.6	1254	PCT-US96-05320A-894	Sequence 894, App
16	123.6	5.6	1830121	US-09-557-884-1	Sequence 1, Appli
17	123.6	5.6	1830121	US-09-643-990A-1	Sequence 1, Appli
18	116.8	5.3	3230	US-08-961-527-203	Sequence 203, App
19	115.2	5.2	3347	US-09-702-705-318	Sequence 318, App
20	115.2	5.2	3347	US-09-736-457-318	Sequence 318, App
21	115.2	5.2	3347	US-08-614-124B-318	Sequence 318, App
22	115.2	5.2	3347	US-08-671-325-318	Sequence 318, App
23	115.2	5.2	3347	US-08-589-184-318	Sequence 318, App
24	115.2	5.2	3825	US-08-208-742-3	Sequence 3, Appli
25	113.4	5.1	1317	US-09-543-681A-195	Sequence 195, App
26	110.4	5.0	45613	US-09-596-002-22	Sequence 22, Appl
27	110	4.9	1941	US-09-328-352-1891	Sequence 1891, Ap

ALIGNMENTS

RESULT 1

US-09-621-976-2923

; Sequence 2923, Application US/09621976

; Patent No. 6639063

; GENERAL INFORMATION:

; APPLICANT: Dumas Milne Edwards, J.B.

; APPLICANT: Jobert, S.

; TITLE OF INVENTION: ESTS and Encoded Human Proteins.

; FILE REFERENCE: GENSET.054PR2

; CURRENT APPLICATION NUMBER: US/09/621,976

; CURRENT FILING DATE: 2000-07-21

; NUMBER OF SEQ ID NOS: 19335

; SOFTWARE: Patent.pm

; SEQ ID NO 2923

; LENGTH: 504

; TYPE: DNA

; ORGANISM: Homo sapiens

; FEATURE:

; NAME/KEY: CDS

; LOCATION: 224..472

US-09-621-976-2923

Query Match	22.2%	Score 493;	DB 4;	Length 504;
Best Local Similarity	99.8%	Pred. No. 8.9e-134;		
Matches 504;	Conservative	0;	Mismatches 0;	Indels 1; Gaps 1;
QY	775	TCAGACTCCATCTTTGCACATTTATCAGACAGGATTAACCTTCGACAAATACGACACTAT	834	
Db	1	TCAGACTCCATCTTTGCACATTTATCAGACAGGATTAACCTTCGACAAATACGACACTAT	60	
QY	835	TCCTTGTGAAGTGTCTGGACATGATGCACACAGCAATTCGACTTTTGAAGAAGCTAA	894	
Db	61	TCCTTGTGAAGTGTCTGGACATGATGCACACAGCAATTCGACTTTTGAAGAAGCTAA	120	
QY	895	TCTCTGTGAGACATGAAATAACAATTCGCTGATTAAGTGGTATTAAGTCTTCTCTGT	954	
Db	121	TCTCTGTGAGACATGAAATAACAATTCGCTGATTAAGTGGTATTAAGTCTTCTCTGT	180	
QY	955	GCAGAAATACAGTATTCCTATCATATTCGAGGAGAGATTTGATGGCTTGTGCTCAAC	1014	
Db	181	GCAGAAATACAGTATTCCTATCATATTCGAGGAGAGATTTGATGGCTTGTGCTCAAC	240	
QY	1015	AGGGTCTGGAGAGACTGGGGCTTTTCTCCTACCAATTTGGCTCATATGATGATGATGG	1074	
Db	241	AGGGTCTGGAGAGACTGGGGCTTTTCTCCTACCAATTTGGCTCATATGATGATGATGG	300	
QY	1075	AATACTGCCAGTCTGTTTAAAGAGTTCAGAACCCAGAGTCTATTATTGTAGCCCAAC	1134	
Db	301	AATACTGCCAGTCTGTTTAAAGAGTTCAGAACCCAGAGTCTATTATTGTAGCCCAAC	360	

